

REMARKS

At the time of the Office Action dated April 16, 2007, claims 1-18 were pending and rejected in this application.

In the first enumerated paragraph on page 2 of the Office Action, the Examiner asserted that the Information Disclosure Statement (IDS) filed August 6, 2003, "fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the citation for the reference *Simplifying Network Administration using Policy based Management* lacks the date of publication and a listing of relevant pages." Applicants also note that besides the reference listed above, the Examiner failed to consider any of the other references cited in the IDS.

In response, the Examiner is directed to the fourth paragraph in M.P.E.P. § 609.05(a), which is reproduced below:

If an item of information in an IDS fails to comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98, that item of information in the IDS will not be considered and a line should be drawn through the citation to show that it has not been considered. However, other items of information that do comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the examiner. (emphasis added).

Thus, despite the Examiner's assertion that the above-identified reference was not properly cited, it is improper for the Examiner to have ignored all the other references cited in the IDS.

Therefore, Applicants respectfully request that the Examiner clarify the record by acknowledging receipt of the Information Disclosure Statement filed August 3, 2001, and provide an appropriately initialed copy of the PTO-1449 form indicating consideration of the cited prior art. With regard to the above-identified reference listed above alleged not to have included the page numbers, Applicants note that this reference is only 8 pages long, and thus, pages 1-8 were cited.

In the second enumerated paragraph on page 2 of the Office Action, the Examiner asserted the following:

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the term "machine readable storage" recited in claims 11-18 lacks antecedent basis in the specification.

Applicants respectfully disagree with the Examiner's analysis. 37 C.F.R. § 1.75(d)(1) states the following:

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (emphasis added)

As emphasized above, "antecedent basis" is not necessarily required from the specification. Instead, "clear support" for the meaning of the term can also satisfy the requirements of 37 C.F.R. § 1.75(d)(1). It is well-established that the originally-filed claims are considered part of the specification, and thus, the term "machine readable storage" is also found in the specification. Moreover, the term "machine readable storage" is self-defining. For example, one is not required to further define such terms "computer" or "bicycle" or "golf club" since those skilled in the art readily recognize the meaning of these terms. Similarly, Applicants submit that one having ordinary skill in the art would readily recognize the subject matter encompassed by the term "machine readable storage." For example, "machine readable storage" includes, but is not limited to, such devices as hard drives, floppy drives, key drives, and memory. Applicants, therefore, respectfully solicit withdrawal of the imposed objection to the specification based upon 37 C.F.R. § 1.75(d)(1).

CLAIMS 9 AND 10 ARE REJECTED UNDER 35 U.S.C. § 101

On page 3 of the Office Action, the Examiner asserted that the claimed invention, as recited in claims 9 and 10, is directed to non-statutory subject matter. This rejection is respectfully traversed.

In the third and fourth full paragraphs on page 3 of the Office Action, the Examiner asserted the following:

3. Regarding claim 9, the elements "an administration policy" and "an exit routine" refer to software *per se*. Furthermore, applicant's specification defines "components." as including "application components" and "software resources" (see paragraph 10017)). Therefore, applicant's specification provides evidence that the element "a policy evaluation component" is also intended to encompass software *per se*. In the absence of a structurally and functionally interrelated computer-readable medium, software *per se* is not statutory subject matter. See MPEP §2106.01.
4. Regarding claim 10, the element "a rules engine" refers to software *per se*, and is rejected for the reasons above.

A discussion of descriptive material, both functional and non-functional, is found in M.P.E.P. 2106.01.¹ As described therein, "'functional descriptive material' consists of data structures and computer programs which impart functionality when employed as a computer component." Also, descriptive material of either type is nonstatutory when claimed as descriptive material, *per se*.²

Applicants submit that the Examiner misunderstands the use of the term "*per se*." The definition of "*per se*" is the following:³

By itself; in itself; taken alone; by means of itself; through itself; inherently; in isolation; unconnected with other matters; simply as such; in its own nature without reference to its relation.

¹ Rev. 5, August 2006.

² *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

³ Black's Law Dictionary 1142 (6th ed. 1990).

For example, the claim at issue within In re Warmerdam⁴ was to a data structure, *per se*.

Specifically claim 6 of In re Warmerdam recited "[a] data structure generated by the method of any of Claims 1 through 4." Thus, claim 6 of In re Warmerdam was directed to a data structure, in isolation. Claim 9 of the present application, however, is not directed to either a data structure or computer program, in isolation.

Not only are the claims not directed to functional descriptive material, *per se*, the claims are not directed to functional descriptive material or "software alone," as asserted by the Examiner. In contrast, the claimed invention is directed to a system. Moreover, the claimed system includes functional components with structure (e.g., "a policy evaluation component configured to retrieve resource state data" and an exit routine coupled to a resource in said network"). Software or functional descriptive material, *per se*, is incapable of being functional since software, *per se*, (i.e., an abstract idea) is unconnected to anything else. Since the claimed system includes functional components, the system must include and/or be coupled to physical components (i.e., hardware) to be functional. Therefore, the claimed system constitutes statutory subject matter within the meaning of 35 U.S.C. § 101.

With regard to the Examiner identifying certain features in claims 9 and 10 and asserting that these certain features "refer to software *per se*," the Examiner is referred to the M.P.E.P. § 2106(II)(A), which states:

Finally, when evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. at 188-89, 209 USPQ at 9 ("In determining the eligibility of respondents' claimed process for patent protection under 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the

⁴ 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994).

presence of the old elements in the analysis. This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made."'). (emphasis in original)

The Examiner, however, is not evaluating the claimed invention, as a whole. Instead, the Examiner is improperly evaluating certain elements of the claims in isolation.

The Examiner is further referred to M.P.E.P. § 2106(II)(A), which states:

Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101. Compare *Musgrave*, 431 F.2d at 893, 167 USPQ at 289; *In re Foster*, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971). Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.

The Examiner, however, has not made any *prima facie* case, as described above.

Therefore, for the reasons stated above, Applicants submit that the imposed rejection of claims 9 and 10 under 35 U.S.C. § 101 is not viable. Thus, Applicants respectfully solicit withdrawal thereof.

CLAIMS 6 AND 16 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

On page 4 of the Office Action, the Examiner asserted the following:

The term "autonomically" in claims 6 and 16 is used by the claim to mean "without the manual intervention of a human operator", while the accepted meaning is "in a manner related to the portion of the vertebrate nervous system that governs involuntary actions." The term is indefinite because the specification does not clearly redefine the term.

Applicants respectfully disagree with the Examiner's conclusion. In this regard, Applicants submit that the Examiner has failed to establish a *prima facie* case of indefiniteness under the second paragraph of 35 U.S.C. § 112. M.P.E.P. § 2173.02 states the following:

If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why

the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action.
(emphasis added).

As stated in Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings,⁵ "[o]nly when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite." Applicants' position is that one having ordinary skill in the art would have no difficulty understanding the scope of claims 6 and 16, particularly when reasonably interpreted in light of the written description of the specification.⁶

In this regard, Applicants note that a search of Google using the phrase "autonomic computer" in quotes (i.e., "autonomic" must be found immediately preceding the term "computer") yields 18,900 hits, and the term "autonomic" used in conjunction with "computer" yields 1.61 million hits. Therefore, Applicants' position is that one having ordinary skill in the art would recognize that the term "autonomic" has been used in conjunction with computers. Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 6 and 16 under the second paragraph of 35 U.S.C. § 112 has been overcome and, hence, Applicants respectfully solicit withdrawal thereof.

⁵ 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004).

⁶ In re Okuzawa, 537 F.2d 545, 190 USPQ 464 (CCPA 1976); In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

CLAIMS 1-2, 9, AND 11-12 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASED UPON LORTZ, U.S. PATENT PUBLICATION 2003/0018786, IN VIEW OF HOPMANN ET AL.,
U.S. PATENT NO. 6,499,031 (HEREINAFTER HOPMANN)

On pages 5-7 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Lortz in view of Hopmann to arrive at the claimed invention. This rejection is respectfully traversed.

In the eleventh enumerated paragraph on page 5 of the Office Action, the Examiner asserted the following regarding the teachings of Lortz:

As to claims 1 and 11, Lortz shows a systems administration policy enforcement method, and a machine readable storage having stored thereon a program for causing a machine to perform such a method (inherent to any computer-implemented system), comprising: responsive to a request to perform an administrative task (comprising a resource request, which can include administrative tasks such as editing; see [0021]) directed to a resource (resource device 14) within a computing network (network 16), retrieving an administration policy comprising a set of rules for governing said administrative task (the policy comprising policy data and the rules comprising access control entries; see [0019] and [0044]-[0045]), and permitting said administrative task only if a set of rules in said retrieved policy are satisfied (see step 310 in Fig. 4C and [0045]).

Applicants respectfully disagree with the Examiner's analysis for several reasons.

For example, the Examiner cited paragraph [0021] of Lortz to teach the claimed "responsive to a request to perform an administrative task." For ease of reference, paragraph [0021] is reproduced below:

In addition, the ACE attribute 43 can include an access permission level attribute 44 that can be set to one of four access levels of permission in decreasing order of authority: (1) "owner" level which is the highest level of access, (2) "editor" level which allows access for editing, (3) "reviewer" level which allows access for reading only, and (4) "none" level which denies all access. The interpretation of the values specified in the access permission level attribute 44 can depend on the particular resource device 14. The permission level attribute 44 can be arranged to provide a hierarchy of permission levels. For example, a principal with a high access permission level also may be granted the privileges associated with a lower access permission level.

Absent from this teaching is "a request to perform an administrative task" (emphasis added).

Thus, the Examiner has failed to properly identify within Lortz the features being relied upon in the statement of the rejection.

Regarding the claimed "retrieving an administration policy comprising a set of rules for governing said administrative task," the Examiner stated "the policy comprising policy data and the rules comprising access control entries." As claimed, the administrative policy is a set of rules for governing the administrative task, which the Examiner has alleged to be "editing."

However, Applicants are unclear where, specifically, the "policy" described by Lortz comprises a set of rules for governing the editing. Moreover, Applicants are unclear where Lortz teaches that the retrieval of the administration policy is "responsive to a request" (emphasis added), as claimed.

Regarding the claimed "permitting said administrative task ...," the Examiner cited step 310 in Fig. 4C and paragraph [0045]. The Examiner's alleged "administrative task" is "editing." However, neither step 310 nor paragraph [0045] is directed to permitting the administrative task of editing. Instead, the Examiner's cited passage refers to permitting a "client access to the resource if the evaluation results indicate that the client is permitted to access to the resource." In this regard, Applicants note that one having ordinary skill in the art would not consider a client being permitted access to a resource as disclosing the claimed "administrative task," given the broadest, reasonable interpretation of the term "administrative task." Thus, the Examiner's cited passages are not directed to permitting an administrative task, as claimed.

Applicants also note that the "policy data" referred to in paragraph [0045] of Lortz is further described in paragraph [0013] of Lortz. Upon reviewing paragraph [0013] of Lortz, Applicants' position is that the policy data described does not refer to "a set of rules for governing said administrative task," as claimed. Therefore, for the reasons stated above, Applicants respectfully submit that Lortz fails to teach or suggest those limitations for which the Examiner is relying exclusively on Lortz to teach.

Regarding the Examiner's obviousness analysis, the Examiner asserted the following in the paragraph spanning pages 5 and 6 of the Office Action:

Lortz does not show retrieving state data for a resource and applying a policy to retrieved state data. Hopmann shows retrieving state data (comprising whether or not a resource is locked) for a resource and applying a policy to retrieved state data (the policy being that a resource is only available if it does not have a lock token: see lines 7-9 of col. 1 and col. 8, line 65 to col.9, line 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Lortz with the evaluation of state data as taught by Hopmann in order to prevent administrative task requests from overwriting one another (see Hopmann, col. 2, lines 14-18).

As already noted above, accessing a resource alone (as taught by both Lortz and Hopmann) does not disclose the claimed "administrative task directed to a resource within a computing network." An administrator, to be an administrator, already has access to the resource. Although selecting which entities may have access to a resource could be considered an administrative task, the selection of who gets to access the source is different from merely accessing the resource, which is described by the applied prior art. Thus, even if Lortz were modified in view of Hopmann, the claimed invention would not result.

Claim 9

Applicants incorporate herein, as also applying to independent claim 9, the arguments previously presented with regard to claim 1. A set of rules for permitting and disallowing

administration of resources in a system, as claimed, is not comparable to a set of rules for permitting and disallowing access to a resource in a system, as taught by Lortz and Hopmann.

Applicants, therefore, respectfully submit that the imposed rejection of claims 1-2, 9, and 11-12 under 35 U.S.C. § 103 for obviousness based upon Gerken in view of Barsness is not viable, and hence, Applicants solicit withdrawal thereof.

CLAIMS 3 AND 13 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON LORTZ IN VIEW OF HOPMANN AND FURTHER IN VIEW OF BELL ET AL., U.S. PATENT NO. 6,880,005 (HEREINAFTER BELL)

On pages 7 and 8 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Lortz in view Hopmann and Bell to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 3 and 13 respectively depend from independent claims 1 and 11, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 11 under 35 U.S.C. § 103 for obviousness based upon Lortz in view Hopmann. The tertiary reference to Bell does not cure the argued deficiencies of the prior rejection. Accordingly, even if one having ordinary skill in the art were motivated to modify Lortz in view Hopmann and Bell, the claimed invention would not result. Applicants, therefore, respectfully submit that the imposed rejection of claims 3 and 13 under 35 U.S.C. § 103 for obviousness based upon Lortz in view Hopmann and Bell is not viable, and hence, Applicants solicit withdrawal thereof.

**CLAIMS 4-7 AND 14-17 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASED UPON LORTZ IN VIEW OF HOPMANN AND FURTHER IN VIEW OF BURNS ET AL., U.S.
PATENT PUBLICATION NO. 2003/0014644 (HEREINAFTER BURNS)**

On pages 8-10 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Lortz in view Hopmann and Bell to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 4-7 and 14-17 respectively depend from independent claims 1 and 11, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 11 under 35 U.S.C. § 103 for obviousness based upon Lortz in view Hopmann. The tertiary reference to Burns does not cure the argued deficiencies of the prior rejection. Accordingly, even if one having ordinary skill in the art were motivated to modify Lortz in view Hopmann and Burns, the claimed invention would not result. Applicants, therefore, respectfully submit that the imposed rejection of claims 4-7 and 14-17 under 35 U.S.C. § 103 for obviousness based upon Lortz in view Hopmann and Burns is not viable, and hence, Applicants solicit withdrawal thereof.

**CLAIMS 8 AND 18 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED
UPON LORTZ IN VIEW OF HOPMANN AND FURTHER IN VIEW OF HALL, U.S. PATENT NO.
5,930,479**

On pages 10 and 11 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Lortz in view Hopmann and Hall to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 8 and 18 respectively depend from independent claims 1 and 11, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 11 under 35 U.S.C. § 103 for obviousness based upon Lortz in view Hopmann. The tertiary reference to Hall does not cure the argued deficiencies of the prior rejection. Accordingly, even if one having ordinary skill in the art were motivated to modify Lortz in view Hopmann and Hall, the claimed invention would not result. Applicants, therefore, respectfully submit that the imposed rejection of claims 8 and 18 under 35 U.S.C. § 103 for obviousness based upon Lortz in view Hopmann and Hall is not viable, and hence, Applicants solicit withdrawal thereof.

**CLAIM 10 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON LORTZ
IN VIEW OF HOPMANN AND FURTHER IN VIEW OF KRUMEL, U.S. PATENT PUBLICATION NO.
2002/0083331**

On page 11 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Lortz in view Hopmann and Krumel to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 10 depends from independent claim 9, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 9 under 35 U.S.C. § 103 for obviousness based upon Lortz in view Hopmann. The tertiary reference to Krumel does not cure the argued deficiencies of the prior rejection. Accordingly, even if one having ordinary skill in the art were motivated to modify Lortz in view Hopmann and Krumel, the claimed invention would not result. Applicants, therefore, respectfully submit that the imposed rejection of claim 9 under

Application No.: 10/635,586

35 U.S.C. § 103 for obviousness based upon Lortz in view Hopmann and Krumel is not viable, and hence, Applicants solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

Application No.: 10/635,586

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: July 16, 2007

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

Phone: (561) 922-3845

CUSTOMER NUMBER 46320